

Serial No. 10/564,420

Docket No. NL030829

REMARKS

Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks. Claims 1-5 remain pending herein and stand rejected. Claim 6 has been added to address another aspect of the invention.

As an initial matter, the title of the invention was rejected as being not descriptive (Paragraph 2 of the Office Action). In response, Applicant has amended the title. Accordingly, Applicant respectfully requests that the objection be withdrawn.

Claims 1-3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hwang et al. (U.S. 6,317,170) in view of Aizenberg et al. (US 2004/0174610). Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hwang in view of Aizenberg, in further view of Callison et al. (US 2002/0180869).

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reason for rejecting the claims. A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

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With regard to claim 1, this claim recites:

1. A projection device, comprising:

means (4a, 4b, 5, 6) for directing a plurality of light beams (3a, 3b, 3c) onto a scanning device (13), adapted to scan said beams in order to project an image on a surface, characterized by an adjustable lens arranged in the optical path of said beams after said scanner so that the scanner is located between the lens and its focal length.

As recited in the claim, the scanner is located between the (adjustable) lens and its focal length. This feature of the claim is clearly illustrated in Fig. 3 with the scanning device and the adjustable lens being depicted as items 13 and 14, respectively.

In Paragraph 5 of the Office Action, the Examiner recites various items of Hwang's Fig. 2 (or Fig. 3?) as teaching features of claim 1. In addressing the particular feature that "a' lens is arranged in the optical path of the beams after the scanner so that the scanner is located between the lens and its focal length," the Examiner references col. 2, lines 41-45 of Hwang. This cited passage relates to Hwang's discussion of the prior art (and not his invention) in which an f.theta lens is depicted in Fig. 1. Further, Hwang notes (describing the structure of Fig. 1):

In the structure as described above, the size of the image is determined [emphasis added] by the scanning angle and the scanning angle is determined by the horizontal scanning angle. The horizontal scanning angle is determined by the number of surfaces on the rotating polygonal mirror. (col. 2, lines 46-49)

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Accordingly, Applicants submit that the f-theta lens of the prior art depicted in Fig. 1 of Hwang teaches away from the use of a scanner located between an adjustable lens and its focal length.

Moreover, Hwang's invention fails to teach or suggest this feature. That is, in Figs. 2 and 3 of Hwang, the scanning device 900 appears adjacent to surface 1000. This is contrary to the claimed invention, wherein the scanner is located between the (adjustable) lens and its focal length -- an example of which is illustrated in Fig. 3 of the present invention wherein the adjustable lens appears between the scanning device and the surface 22.' Still further, Hwang's invention teaches away from the use of such an adjustable lens:

The projection length from the means for scanning (900) and the vertical-scanning angle as well as the horizontal-scanning angle determines [emphasis added] the size of screen (1000) which is implemented. (col. 21, lines 3-7)

Clearly, Hwang neither teaches nor suggests the use of an adjustable lens positioned between the scanning device and the surface onto which the image is projected.

Paragraph 6 of the Office Action introduces Aizenberg to teach the features of an electro-wetting adjustable lens. However, Aizenberg fails to teach the use of such a lens in a projection device as disclosed by Hwang. Moreover, as Hwang teaches away from such a combination, this rejection cannot be sustained. That is, the combination of these two references lacks both a motivation to combine and a reasonable expectation of

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success. In addition, the prior art combined references fails to teach or suggest all the claim limitations.

Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. id. quoting In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the

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cited reference to reject the claims. Accordingly, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn.

Claims 2-5 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn.

Newly added claim 6 incorporates the projection device of claim 1 with a rear display. This rear display is depicted as item 18 in Fig. 1. This figure also illustrates the use of a mirror (20) as a selection device to select between the projection mode and the local rear display mode. Support for these features is also found in the specification, inter alia at paragraph [0020] of the application as published. Applicant submits that claim 6 is patentable over the art of record.

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For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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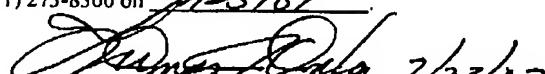
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